

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. APPLICATION NO. 09/864,457
ATTORNEY DOCKET NO. Q64695

REMARKS

Claims 1-9 have been examined on their merits, and are all the claims presently pending in the application.

1. Claims 1, 2, 4, 5 and 7-9 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Venkatesan *et al.* (U.S. Patent No. 6,282,550). Applicants respectfully traverse the rejection of claims 1, 2, 4, 5 and 7-9 for at least the reasons discussed below.

Venkatesan *et al.* disclose, *inter alia*, a method and system for ordering synthesized peptides, oligonucleotides or peptide nucleic acids from various suppliers. As clearly illustrated in Figure 2A (at step 8) and Figure 3A (at step 19), the customer requests a particular synthesized strand of peptide, oligonucleotide or peptide nucleic acid from one or more suppliers, and the suppliers respond back to the customer in the affirmative if they can provide the synthesized strand. However, Venkatesan *et al.* fail to teach or suggest a step of at least acquiring a time when a supplier can supply a particular service and making a selection of a supplier based on at least that criteria, as recited in claim 1. In the February 11, 2005 Non-Final Office Action, the Patent Office cites col. 10, lines 27-37 and 50-52 of Venkatesan *et al.* as allegedly teaching this recitation. However, a fair reading of the cited passage does not support the Patent Office's interpretation. The cited passages disclose the ordering of a synthesized strand of peptide, oligonucleotide or peptide nucleic acid and the searching for suppliers (within a database) that can supply the desired synthesized strand of peptide, oligonucleotide or peptide nucleic acid. There is no disclosure of acquiring a time for when the desired synthesized strand of peptide,

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oligonucleotide or peptide nucleic acid can be delivered. The selection of synthesized strand suppliers is discussed, but there is no disclosure that the time when a supplier can supply a requested synthesized strand is considered to be a selection criterion. Moreover, the language of claim 1 is directed towards supplying a service (e.g., interpreting medical tests), whereas the disclosure of Venkatesan *et al.* is directed to supplying a desired product.

To the extent that the Patent Office is making an implicit inherency argument in rejecting claim 1, Applicants remind the Patent Office that the fact that a certain element *may* be present in the prior art is *not* sufficient to establish the inherency of that element. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82 (CCPA 1981). It is clear that Venkatesan *et al.* do not consider information on when a desired service can be supplied to be a supplier selection criterion.

Based on the foregoing reasons, Applicants submit that Venkatesan *et al.* fail to disclose all of the claimed elements as arranged in claim 1. Applicants submit that claim 1 is allowable, and further submit that claim 7 is allowable as well, at least by virtue of its dependency from claim 1. Applicants respectfully request that the Examiner withdraw the § 102(e) rejection of claims 1 and 7.

With respect to independent claim 2, Applicants submit that claim 2 is allowable for at least reasons analogous to those discussed above with respect to claim 1, in that Venkatesan *et al.* fail to teach or suggest at least a step of acquiring a time when a supplier can supply a particular service and selecting a supplier based on at least that criteria. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 2 is allowable, and further submit that

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claim 8 is allowable as well, at least by virtue of its dependency from claim 2. Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 2 and 8.

With respect to independent claim 4, Applicants submit that claim 4 is allowable for at least reasons analogous to those discussed above with respect to claim 1, in that Venkatesan *et al.* fail to teach or suggest at least a step of acquiring a time when a supplier can supply a particular service and selecting a supplier based on at least that criteria. Therefore, under *Hybritech* and *Richardson*, Applicants submit that claim 4 is allowable, and further submit that claims 5 and 9 are allowable as well, at least by virtue of their dependency from claim 4.

Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 4, 5 and 9.

2. Claims 3 and 6 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Venkatesan *et al.* Applicants respectfully traverse the rejection of claims 3 and 6 for at least the reasons discussed below.

Since claim 3 depends upon claims 1 and 2, and since the Patent Office does not cite a reference that cures the deficient teachings of Venkatesan *et al.* with respect to claims 1 and 2, Applicants submit that claim 3 is allowable at least by reason of its dependency from claims 1 and 2.

Since claim 6 depends upon claims 4 and 5, and since the Patent Office does not cite a reference that cures the deficient teachings of Venkatesan *et al.* with respect to claims 4 and 5,

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Applicants submit that claim 6 is allowable at least by reason of its dependency from claims 4 and 5.

Thus, Applicants respectfully request that the Patent Office withdraw the § 102(e) rejection of claims 3 and 6.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Paul J. Wilson
Registration No. 45,879

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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